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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/538,688	12/19/2005	Michael Sasha John	1436/68977-PCT-US	6768
23432	7590	01/21/2010	EXAMINER	
COOPER & DUNHAM, LLP			EISEMAN, ADAM JARED	
30 Rockefeller Plaza			ART UNIT	
20th Floor			PAPER NUMBER	
NEW YORK, NY 10112			3736	
			MAIL DATE	DELIVERY MODE
			01/21/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/538,688

Applicant(s)

JOHN, MICHAEL SASHA

Examiner

ADAM J. EISEMAN

Art Unit

3736

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above claim(s) 12-19, 22-38 and 44-56 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 20, 21 and 39-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/06)
Paper No(s)/Mail Date 6/10/2005, 10/27/2009
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of group I, claims 1-11, 20-21 and 39-43 in the reply filed on 10/27/2009 is acknowledged.

Information Disclosure Statement

2. The information disclosure statements (IDS) submitted on 6/10/2005 and 10/27/2009 were received and placed in the record on file. The submissions are in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statements are being considered by the examiner.

Claim Objections

3. Claim 20 is objected to because of the following informalities: in line 7, "lest" should read as "least". Appropriate correction is required.

Double Patenting

4. Claims 1-4, 7-9, 21 and 40-41 of this application conflict with claims 1-4, 7-9, 21 and 40-41 of Application No. 10/913997. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

5. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to

identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

6. Claims 1-4, 7-9, 21 and 40-41 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-4, 7-9, 21 and 40-41 of copending Application No. 10/913997. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 1-11, 20, 39-403 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Independent claims 1, 11, 20 and 40 disclose method steps without any clear tie to a physical structure because of the analysis of the acquired results can be performed by hand, and also fail to claim a physical transformation of the calculated result. The analysis steps must have a clear tie to a physical structure or there must be a physical transformation of the results for the claims to be statutory. See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

Claim 21 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The current claim invokes 112 6th paragraph to claim a computer program to perform the signal analysis and providing a pass/fail result. A

computer program is not comprised of any structure, nor is a computer program a physical object. Therefore the claim is non-statutory.

Claim Rejections - 35 USC § 112

9. Claim 21 is rejected under 35 USC 112 sixth paragraph, as for providing claim limitation that do not have a corresponding structure in the current specification.

Claim elements “means for performing signal analysis”, “means for statistically evaluating”, and “means for providing a pass/fail result” are mean (or step) plus function limitations that invokes 35 USC 112, sixth paragraph. However, the written description fails to clearly link or associate the disclosed structure, material, or acts to the claimed function such that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function. Based on the current specification, the means for “performing signal analysis”, “statistically evaluating”, and “providing a pass/fail result” are nothing more than a computer program. Thus the claim limitations are being interpreted as a computer program.

Applicant is required to:

- a. Amend the claim so that the claim limitation will no longer be a means(or step) plus function limitation under 35 USC 112, sixth paragraph;
- b. Amend the written description of the specification such that it clearly links or associates the corresponding structure, material, or acts to the claimed function without introducing any new matter (35 USC 132(a)); or

- c. State on the record where the corresponding structure, material, or acts are set forth in the written description of the specification that perform the claimed function.

For more information see 37 CFR 1.75(d) and MPEP §§ 608.01(o) and 2181.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1-11 and 20-21 are rejected under 35 U.S.C. 102(e) as being anticipated by John et al (US 2001/0049480).

The applied reference has a common inventor with the instant application.

Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Regarding claims 1-11, 20-21 and 39; the methods as claimed are disclosed in paragraphs [0136]-[0137], [0143], [0150], [0154]-[0157], [0193], [0301] and [0332]. A rapid hearing test is disclosed in paragraph [0301]. It is inherent that the test results from the hearing test in paragraph [0137] would yield a pass/fail result as the audiologist administering the test would determine from the results that a person has passed or failed.

Regarding claim 20; the method as claimed is disclosed in paragraphs [0136]-[0137] and [0301]-[0302].

Regarding claim 21; the method as claimed is disclosed in paragraph [0136]-[0143].

12. Claims 1-3, 7, 9, 20-21 and 40-43 are rejected under 35 U.S.C. 102(b) as being anticipated by MASTER (examiner included NPL by John et al).

Regarding claims 3, 7, 9, 20-24 and 40-43; MASTER discloses the use of the MASTER system to provide a modulated stimulus, record responses, analyze acquired signals and evaluate the result data to determine the presence of an auditory response. One of ordinary skill would have been able to recognize that the recognition of the presence or lack of a response inherently provides a pass/fail result (see whole document).

13. Claims 1-3, 7, 9, 20-21 and 40-43 are rejected under 35 U.S.C. 102(b) as being anticipated by Master: Stimulus and Recording Parameters (examiner included NPL; herein referred to as MASTER: Stimulus).

MASTER: Stimulus discloses the use of MASTER to provide a modulated stimulus, record responses, analyze the acquired signals and evaluate the result data to determine the presence of an auditory response. One of ordinary skill would have been able to recognize that the recognition of the presence or lack of a response inherently provides a pass/fail result (see whole document).

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Human Auditory Steady State Responses by Picton; examiner provided NPL.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ADAM J. EISEMAN whose telephone number is (571)270-3818. The examiner can normally be reached on Monday-Friday 9:00 AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571)272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AE
1/16/2010
/A. J. E./
Examiner, Art Unit 3736

/Max Hindenburg/
Supervisory Patent Examiner, Art Unit 3736